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EXAMINER

KANG, PAUL H

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2444

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/761,864	Applicant(s) WHITE ET AL.	
	Examiner Paul H. Kang	Art Unit 2444	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-17 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No.

10/761,883, claims 1-15 of copending Application No. **10/761894**, and claims 1-24 of copending Application No. **10/972,765**. Although the conflicting claims are not identical, they are not patentably distinct from each other because the context of the instant claims are the same as the context of the conflicting claims. The instant application and the copending applications all claim a system for rejecting or diverting spam messages by determining whether the message contains spam messages and diverting or terminating the connection of the transfer session.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-7, 10-11, 14, 16 and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Donaldson, US Pat. No. 7,249,175.

5. As to claims 1, 16 and 17, Donaldson teaches an unsolicited message diverting communications processor connected to message transfer agents MTA_0 with an Internet address of IP_0, from-address A_0, declared domain of D0, and actual domain of DD_0, and MTA_1 with an Internet address of IP_1 and to-address A_1 comprising:

a) monitoring means for monitoring the communications between MTA_0 and MTA_1 (col. 8, lines 25-36);

b) determining means for determining if the communications contains an unsolicited message and intercepting means for intercepting a RCPT replay from MTA_0, substituting diversion address A'_1 for to-address A_1 in RCPT reply and sending modified RCPT reply to

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MTA_1 if the message is determined to be unsolicited and if to-address is in the save_spam database (col. 40, lines 29-45; see also Figs. 13, 26 and 27; col. 15, lines 50-65; col. 3, line 57 - col. 4, line 2; in step 1656 and 1657 the recipient address is appended when the file is to be quarantined; see col. 42, lines 31-34 and 43-45);

wherein the unsolicited message diverting communications processor does not intercept communications between MTA_0 and MTA_1 before a RCPT command from MTA_0 is received by the unsolicited message diverting communications processor, and whereby the connection with MTA_0 is rejected before the data portion of the unsolicited message is transmitted (Once the RCPT command is received by the proxy, it is determined that a message is unsolicited and filtered accordingly; See Figs. 26 and 27; see also col. 40, lines 21-39, col. 3, lines 51-60 and col. 19, lines 23-26; Connection is rejected before the data portion is transmitted; See also Fig. 14 and col. 4, lines 3-8).

6. As to claim 2, Donaldson teaches the unsolicited message diverting communications processor further includes a allow_address database and wherein the determining means determines if a message is not unsolicited by checking if the IP_0 is in the allow_address database (col. 11, line 58 -col. 12, line 10).

7. As to claim 3, Donaldson teaches the unsolicited message diverting communications processor further includes a prevent_address database and wherein the determining means determines if a message is unsolicited by checking if IP_0 is in the prevent_address database (col. 11, line 58 -col. 12, line 10).

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8. As to claim 4, Donaldson teaches the unsolicited message diverting communications processor further includes access to a open relay database and wherein the determining means determines if a message is unsolicited by checking if IP_0 is in the open relay database (col. 11, line 58 -col. 12, line 10).

9. As to claim 5, Donaldson teaches the unsolicited message diverting communications processor further includes access to a DNS (domain name server) database and wherein the determining means determines if a message is unsolicited by checking if IP_0 has a domain name entry DD_0 in the DNS database (col. 11, line 58 -col. 12, line 10).

10. As to claim 6, Donaldson teaches the unsolicited message diverting communications processor further includes a bad_from database and wherein the determining means determines if a message is unsolicited by checking if the from-address A_0 is in the bad_from database (col. 11, line 58 -col. 12, line 10 and col. 43, lines 7-39).

11. As to claim 7, Donaldson teaches the unsolicited message diverting communications processor further includes a suspect_domain database and wherein the determining means determines if a message is unsolicited by checking if the actual domain DD_0 matches the domain of from-address A 0 and the domain of from-address A 0 is in the suspect_domain database (col. 11, line 58 -col. 12, line 10 and col. 21, lines 52-67).

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12. As to claim 10, Donaldson teaches the unsolicited message diverting communications processor wherein the determining means determines if a message is unsolicited by checking if the declared domain D₀ of MTA₀ does not match the actual domain of DD₀ and the declared domain D₀ is in the suspect_domain database (col. 11, line 58 -col. 12, line 10 and col. 21, lines 52-67).

13. As to claim 11, Donaldson teaches the unsolicited message diverting communications processor further includes a no_filter database and wherein the determining means determines if the message is to be blocked by checking if to-address A₁ is in the no-filter database (col. 11, line 58 -col. 12, line 10).

14. As to claim 14, Donaldson teaches a method for a receiving networked computer system with an Internet connection, a .mail transfer agent MTA₁, an Internet address IP₁, to-address A₁, a diversion address A'₁, a save_spam database (col. 13, lines 26-49; col. 40, lines 29-45; see also Figs. 13, 26 and 27; col. 15, lines 50-65), and an operating system capable of executing the method to divert unsolicited messages from a transmitting networked computer system with an Internet connection and a message transfer agent MTA₀ (col. 11, lines 13-33), an Internet address IP₀, from-address A₀, declared domain D₀, and actual domain DD₀ (See col. 18, lines 5-7, col. 15, lines 62-64, col. 20, lines 4-5 and col. 3, lines 5-6) comprising the steps of:

a) waiting for a new SMTP connection request (col. 15, lines 21-31); b) relaying and monitoring the replies from MTA₀ to MTA₁ (col. 8, lines 25-28); c) relaying replies from MTA₁ to MTA₀ (col. 34, lines 3-5); d) intercepting the RCPT reply from MTA₀ to

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MTA_1(col. 34, lines 3-5) ; e) determining if the message is unsolicited by analyzing the monitored replies (col. 15, lines 50-65); f) releasing the intercepted RCPT reply if the message is determined not to be unsolicited (col. 40, lines 29-34 and col. 20, lines 6-23 and col. 44, lines 3-16); and g) substituting diversion address A'1_1 for to-address A_1 in the RCPT reply and sending the modified replay to MTA_1 if the message is determined to be unsolicited and if recipient address A_1 is in the save_spam database (col. 40, lines 29-45; see also Figs. 13, 26 and 27; col. 15, lines 50-65; col. 3, line 57 - col. 4, line 2);

whereby MTA_1 controls the interaction between MTA_0 and MTA_1 until a .\r\n end-of-message indicator reply is received from MTA_0 (col. 40, lines 29-34 and col. 20, lines 6-23 and col. 44, lines 3-16).

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Donaldson in view of Levosky, in view of Wilson, US Pat. App. Pub. No. 2004/0015554.

17. As to claim 8, Donaldson teaches the invention substantially as claimed. However, Donaldson does not explicitly teach the unsolicited message diverting communications processor wherein the determining means determines if a message is unsolicited by checking if the from-

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address A_0 matches the to-address (A_1). In the same field of endeavor, Wilson teaches the unsolicited message diverting communications processor wherein the determining means determines if a message is unsolicited by checking if the from-address A_0 matches the to-address (A_1) (Wilson, paragraph 0084). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the known technique of matching from address to the to address to determine junk mail as taught by Wilson into the known unsolicited mail diverting system of Donaldson for the predictable result of providing alternative methods of detecting junk mail.

18. As to claim 9, Donaldson teaches the unsolicited message diverting communications processor wherein the determining means determines if a message is unsolicited by checking if the declared domain D_0 of MTA_0 is the same as the domain D_1 of MTA_1 (Wilson, paragraph 0084).

19. Claims 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Donaldson in view of Levosky, US Pat. App. Pub. No. US 2002/0087641.

20. As to claim 12, Donaldson teaches the invention substantially as claimed. However, Donaldson does not explicitly teach the unsolicited message diverting communications processor further includes a rejected_connection database which logs the time, from-address A_0, to address A_1, and the reason for the rejection if a message is rejected if the message is determined to be unsolicited. In the same field of endeavor, Levosky teaches the unsolicited message

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diverting communications processor further includes a rejected_connection database which logs the time, from-address A_0, to address A_1, and the reason for the rejection if a message is rejected if the message is determined to be unsolicited (Levosky, paragraphs 0017 and 0063). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the known technique of using logs as taught by Levosky into the known system of Donaldson for the predictable result of enabling the storage of a record of past transactions.

21. As to claim 13, Donaldson-Levosky teaches the unsolicited message diverting communications processor further includes a allowed_connection database which logs the time and to-address A_1 if the message is determine not to be unsolicited) Donaldson, col. 13, lines 26-29, col. 21, lines 14-17; Levosky, paragraphs 001- and 0063).

Response to Arguments

22. Applicant's arguments with respect to claims 1-17 have been considered but are moot in view of the new ground(s) of rejection. The applicants argued in substance that the prior art of record fails to teach an unsolicited message diverting communications processor comprising “substituting the diversion address A’_1 for the to-address A_1 in the RCPT reply and sending a modified RCPT reply to the MTA_1” and further “does not intercept communications between MTA_0 and MTA_1 before a RCPT command from MTA_0 is received by the unsolicited message diverting communications processor.”

The examiner respectfully disagrees. As seen in the cited passages above in reference to

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claim 1, Donaldson clearly teaches that the system does not intercept communications between MTA_0 and MTA_1 before a RCPT command from MTA_0 is received by the unsolicited message diverting communications processor. See figs. 26 and 27; and col. 42, lines 31-34 and 43-45. Further, Donaldson teaches appending the recipient address when a message is determined to be unsolicited and otherwise to be quarantined. See Fig. 27 and col. 42, lines 4-60.

Applicant is reminded the definiteness of the language employed must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Insofar, the claims have been given the broadest reasonable interpretation consistent with the specification and the prior art, since the applicant may then amend his claims, the thought being to reduce the possibility that after a patent is granted the claims may be interpreted as giving broader coverage than is justified. Therefore, applicant's arguments regarding various specific limitations such as "save_spam database," "diversion address A'_1," "to-address A_1," etc., are not given weight as to the patentability of the claimed subject matter. While the prior art may not explicitly use the same terminology as employed by the applicant, the features disclosed therein performs the same functions as that claimed by the applicant.

Conclusion

23. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul H. Kang whose telephone number is (571) 272-3882. The examiner can normally be reached on IFP.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Vaughn can be reached on (571) 272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Paul H Kang/
Primary Examiner
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